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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/816,525	04/01/2004	William J. Johnson	JOHN.7.B	9897

38055 7590 05/03/2005

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EXAMINER	
PARDO, THUY N	

ART UNIT	PAPER NUMBER
2165	

DATE MAILED: 05/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/816,525	JOHNSON, WILLIAM J.	
	Examiner	Art Unit	
	Thuy Pardo	2165	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *01 April 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *01 April 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *6/30/04*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-20 are rejected under the judicially created doctrine of double patenting over claims 1-17 of U. S. Patent No. 6,738,768 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: enabling a user to prevent redundant capture of information.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1-5, 9-15, and 19 are rejected under 35 U.S.C. § 102(e) as being anticipated by **Himmel et al.** (Hereinafter "Himmel") U.S. Patent No. 6,237,035.

As to claim 1, Himmel teaches a data processing system for enabling a user to efficiently capture information [see the abstract], said method comprising the steps of:

monitoring for user invocation of an information capture action [user submits request, 503 of fig. 5] as a user uses said data processing system [monitoring transaction submission requests and detecting duplicates, col. 3, lines 57-58; col. 5, lines 45-65];

determining, upon said user invocation [503 of fig. 5], if said information capture action is a redundant information capture action by searching redundancy determination history information for presence of a previously performed information capture action that matches said information capture action [compare a transaction ID (tranid) obtained from the URL to a tranid history maintained for each client, col. 5, lines 56 to col. 6, lines 24]; and

providing an alert to said user when said information capture action is a redundant information capture action [506 of fig. 5; a response sent back to the user telling the user that a duplicate transaction has been detected and what should be done, col. 7, lines 1-27].

As to claim 2, Himmel teaches the invention substantially as claimed as specified in claim 1 above. Himmel further teaches that said step of providing an alert further includes the step of automatically canceling said information capture action [the duplicate transaction has not been processed, col. 7, lines 12-20, 38-41].

As to claim 3, Himmel teaches the invention substantially as claimed as specified in claim 1 above. Himmel further teaches that said step of providing an alert comprises the step of

providing a warning prompt [506 of fig. 5; col. 7, lines 1-4], said warning prompt requiring user action before leaving the user interface [col. 7, lines 15-21] .

As to claim 4, Himmel teaches the invention substantially as claimed as specified in claim 1 above. Himmel further teaches automatically maintaining said information capture action to said redundancy determination history information [a transaction ID (tranid) history is maintained for each client (user), col. 6, lines 4-7; col. 7, lines 40-42].

As to claim 5, Himmel teaches the invention substantially as claimed as specified in claim 1 above. Himmel further teaches that said step of monitoring for user invocation of an information capture action further includes the step of monitoring according to user configurable tracking variables [col. 5, lines 30-37; col. 6, lines 32-67].

As to claim 9, Himmel teaches the invention substantially as claimed as specified in claim 1 above. Himmel further teaches that said step of determining if said information capture action is a redundant information capture action further includes the step of determining that the information capture action is not redundant when an inconsequential user invocation causes said information is capture action [if tranid has been processed before, save tranid as having been processed, and process user's request and return results, 507, 508 of fig. 5].

As to claim 10, Himmel teaches the invention substantially as claimed as specified in claim 1 above. Himmel further teaches accepting user configurations affecting processing behavior of said data processing system [col. 2, lines 10-16].

As to claim 11, it is a corresponding apparatus claim of claim 1. All the limitations of this claim have been rejected in the analysis of claim 1 above; therefore, this claim is rejected on that basis.

As to claim 12, it is a corresponding apparatus claim of claim 2. All the limitations of this claim have been rejected in the analysis of claim 2 above; therefore, this claim is rejected on that basis.

As to claim 13, it is a corresponding apparatus claim of claim 3. All the limitations of this claim have been rejected in the analysis of claim 3 above; therefore, this claim is rejected on that basis.

As to claim 14, it is a corresponding apparatus claim of claim 4. All the limitations of this claim have been rejected in the analysis of claim 4 above; therefore, this claim is rejected on that basis.

As to claim 15, it is a corresponding apparatus claim of claim 5. All the limitations of this claim have been rejected in the analysis of claim 5 above; therefore, this claim is rejected on that basis.

As to claim 19, it is a corresponding apparatus claim of claim 9. All the limitations of this claim have been rejected in the analysis of claim 9 above; therefore, this claim is rejected on that basis.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 6 and 16 are rejected under 35 U.S.C. § 103 (a) as being unpatentable over **Himmel et al.** (Hereinafter "Himmel") U.S. Patent No. 6,237,035, in view of **Wong et al.** (Hereinafter "Wong") U.S. Patent No. 6,199,058.

As to claim 6, Himmel teaches the invention substantially as claimed as specified in claim 1 above. However, Himmel does not explicitly teach that information capture actions are performed in any time window. Wong teaches that information capture actions are performed in

any time window [col. 4, lines 31-43; col. 6, lines 11-31, particular lines 11-20; 308 of fig. 3A; 604 of fig. 6; col. 5, lines 54-59]. Therefore, it would have been obvious to one of ordinary skill in the Data Processing art at the time of the invention to have modified the communication service system of Himmel wherein the duplicate record detection provided thereof would have incorporated the teachings of Wong especially the methodology of generating a report associated with a matching entry created within a specified time; the motivation being to expand and enhance the versatility of Himmel's system by allowing the report server system to reduce the burden on system resources in processing reports [Wong, col. 1, lines 67 to col. 2, lines 2].

As to claim 16, it is a corresponding apparatus claim of claim 6. All the limitations of this claim have been rejected in the analysis of claim 6 above; therefore, this claim is rejected on that basis.

4. Claims 7, 8, 17, 18, and 20 are rejected under 35 U.S.C. § 103 (a) as being unpatentable over **Himmel et al.** (Hereinafter "Himmel") U.S. Patent No. 6,237,035, in view of **Johnson et al.** (Hereinafter "Johnson") U.S. Patent No. 5,799,302.

As to claim 7, Himmel teaches the invention substantially as claimed as specified in claim 1 above. However, Himmel does not explicitly teach the step of determining if said information capture action is a redundant information capture action by searching redundancy determination history information for presence of a previously performed information capture action that is a subset of said information capture action. Johnson teaches the step of determining

if said information capture action is a redundant information capture action by searching redundancy determination history information for presence of a previously performed information capture action that is a subset of said information capture action [matching fields of records, col. 2, lines 63 to col. 3, lines 23; "Washington=W252" and "Lee=L000" where "W" and "L" are subsets of "W252" and "L000", see col. 8, lines 43 to col. 9, lines 2; col. 7, lines 9-15]. Therefore, it would have been obvious to one of ordinary skill in the Data Processing art at the time of the invention to have modified the communication service system of Himmel wherein the duplicate record detection provided thereof would have incorporated the teachings of Johnson especially the feature that the record is determined to be redundant when its record is a subset of a previously performed record; the motivation being to expand and enhance the versatility of Himmel's system by allowing the system operator to create a new record by filling each empty field with a next available corresponding field from a subsequent record within the duplicate set [Johnson, col. 3, lines 17-23].

As to claim 8, Himmel teaches the invention substantially as claimed as specified in claim 1 above. However, Himmel does not explicitly teach the step of determining if said information capture action is a redundant information capture action by searching redundancy determination history information for presence of a previously performed information capture action that is a superset of said information capture action. Johnson teaches the step of determining if said information capture action is a redundant information capture action by searching redundancy determination history information for presence of a previously performed information capture action that is a superset of said information capture action ["very close" is a

superset of "exact"and "close" is superset of both "very close" and "exact", col. 8, lines 9-35; 43-65]. Therefore, it would have been obvious to one of ordinary skill in the Data Processing art at the time of the invention to have modified the communication service system of Himmel wherein the duplicate record detection provided thereof would have incorporated the teachings of Johnson especially the feature that the record is determined to be redundant when its record is a subset of a previously performed record; the motivation being to expand and enhance the versatility of Himmel's system by allowing the system operator can create a new record by filling each empty field with a next available corresponding field from a subsequent record within the duplicate set [Johnson, col. 3, lines 17-23].

As to claim 17, it is a corresponding apparatus claim of claim 7. All the limitations of this claim have been rejected in the analysis of claim 7 above; therefore, this claim is rejected on that basis.

As to claim 18, it is a corresponding apparatus claim of claim 8. All the limitations of this claim have been rejected in the analysis of claim 8 above; therefore, this claim is rejected on that basis.

As to claim 20, Himmel teaches the invention substantially as claimed as specified in claims 1 and 8 above. However, Himmel does not explicitly teach the feature of enhancing the process of capturing information by detecting information redundancy is applied in a printing process. Johnson teaches that this process is applied in a printing process [see fig. 1B, 3A-3D;

col. 6, lines 63 to col. 7, lines 67]. Therefore, it would have been obvious to one of ordinary skill in the Data Processing art at the time of the invention to have modified the communication service system of Himmel wherein the duplicate record detection provided thereof would have incorporated the teachings of Johnson especially that this process is applied in a printing process; the motivation being to expand and enhance the versatility of Himmel's system by allowing a number of option to provide flexibility [Johnson, col. 3, lines 43-49].

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thuy Pardo, whose telephone number is 571-272-4082. The examiner can normally be reached Monday through Thursday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dov Popovici, can be reached at 571-272-4083.

The fax phone number for the organization where this application or proceeding is assigned are as follows: (703) 872-9306 (Official Communication)

and/or:

571-273-4082 ***(Use this Fax#, only after approval by Examiner, for "INFORMAL" or "Draft" communication. Examiner may request that a formal/amendment be faxed directly to then on occasions).***

Any inquiry of a general nature of relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

6. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

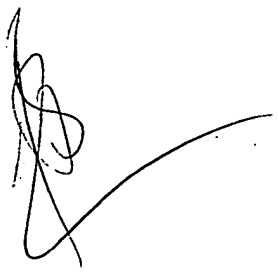
(703) 308-9051, (for formal communications intended for entry)

Or:

(703) 308-5359, (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington. VA., Sixth Floor (Receptionist).

April 29, 2005



THUY N. PARDO
PRIMARY EXAMINER